REMARKS

Claims 18 to 24 are added, and therefore claims 9 to 13 and 15 to 24 are currently pending and being considered in this application.

It is respectfully submitted that pending and considered claims are in condition for allowance.

Claims 9 and 11 to 13 and 15 to 17 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,715,030 to Koch et al. ("Koch").

To reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See* Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejection, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 9, as presented, recites a network bridge, including *a monitoring arrangement for monitoring volume of incoming and outgoing data flowing through the network bridge and its memory, in which the monitoring arrangement for monitoring is configurable by a higher-level instance, and is configured so that in addition to an analysis of the data, operation on the data is performed.* Claim 17, as presented, includes features like those of claim 9, as presented.

It is believed and respectfully submitted that the Koch reference does not identically disclose (or suggest) *a monitoring arrangement for monitoring volume of incoming and outgoing data flowing through the network bridge and its memory, in which the monitoring arrangement for monitoring is configurable by a higher-level instance, and is configured so that in addition to an analysis of the data, operation on the data is performed*, as provided for in the context of claims 9 and 17, as presented.

The Koch reference concerns an apparatus for bridging between two local area networks. The apparatus has two bridge sides each including means for receiving or transmitting a message frame, controller means for directing an incoming message frame into a memory means shared between the bridge sides or directing a frame out of the memory means for transmission, address reading means for reading an address portion of the incoming frame and processor means for determining frame transmissibility from the address portion as provided by the address reading means. The apparatus is configured so that the processor means determines incoming frame transmissibility substantially concurrent with the controller means directing the incoming frame into the memory means.

The Final Office Action appears to rely on a bridge that enables of high bandwidth and high operating speed, and monitoring of bandwidth and the throughput of the network as monitoring of the volume of incoming and outgoing data flowing through the network bridge. (*Paper Number 20081007, p. 6*). Furthermore, the Final Office Action alludes to the ability to sense whether a collision has occurred as measuring the throughput of the network , and asserts that throughput is a measurement that is expressed in terms of the ratio of the volume of data to time. (*Paper Number 20081007, p. 6*). It is respectfully submitted that merely enabling high bandwidth and high operating speed does not identically disclose (or suggest) the monitoring of the volume of incoming and outgoing data flowing through the network bridge.

In this regard, there are three instances in which bandwidth is discussed as to Koch's system. In particular, Koch indicates that it is a desirable feature of a bridge to have a capacity to handle a large number of message frames in as short a time period as possible so that the bridge does not become a communications bottleneck, i.e. a large bandwidth is desired. The Koch reference also refers to providing a LAN bridge that operates with a high bandwidth; and the foregoing objects are accomplished by having a LAN bridge having unique architecture that enables a high bandwidth and a high operating speed. (*Koch, Col. 2,*

lines 20 to 25, lines 44 to 46, lines 55 to 60). Significantly, mere enablement of a bridge operating at high speeds does not identically disclose (or suggest) the monitoring of the actual volume of incoming and outgoing data flowing through the network bridge and its memory. Even if Koch may refer to a bridge capable of high bandwidth and speed, a mere capability to operate with high bandwidth and speed does not identically disclose (or suggest) the feature of monitoring of high bandwidth – let alone the feature of monitoring volume of incoming and outgoing data flowing through the network bridge and its memory, as provided for in context of claims 9 and 17, as presented.

Furthermore, Koch is wholly silent on the concept of throughput, let alone monitoring of the same. Specifically, the term 'throughput' is not disclosed nor suggested in Koch's system. The Office Action cites the text at col. 4, lines 1 to 21, as support for throughput. It is respectfully submitted that neither the term 'throughput' nor the concept of 'throughput' is disclosed or suggested by that particular section or anywhere within the Koch reference. Even if Koch may refer to a transceiver includes means for sensing network collisions and for generating a signal indicating a collision has occurred (*Koch, Col. 4, lines 13 to 15*), a means to sense network collisions merely senses collisions and reporting of the same. Significantly, this type of sensing and reporting does not identically disclose (or suggest) the feature of monitoring the volume of incoming and outgoing data flowing through the network bridge and its memory -- let alone monitoring being configurable by a higher level instance, in which the monitoring arrangement is configured so that in addition to analysis of the data, operation on the data is performed as well, as provided for in context of claims 9 and 17, as presented.

Moreover, Koch does not identically disclose (or suggest) the feature of monitoring a volume of incoming and outgoing data flowing through the network bridge and its memory. The Koch system follows a detailed flow process in determining whether to transmit incoming messages. In particular, a reader reads the source and destination addresses of an incoming message while the frame itself is stored within the bridge 50. *Koch, Col. 8, lines 30 through 40*. Substantially simultaneously, Koch determines whether the frame should be transmitted by using both the source and destination address in the determination. This determination involves determining whether the received frame destination address is included in the source address table. *Koch, Col. 8, lines 29 through 31; Col. 7, lines 50 through 63*.

Determination of whether certain addresses are in a source data table does not identically disclose (or suggest) the feature of *monitoring a volume of incoming and outgoing data*, as provided for in the context of the claimed subject matter. Moreover, a volume of incoming frames does not really concern the Koch system. During the bridge operation, both sides of bridge 50 receive message frames, and processors on both sides determine the transmissibility of the received frames. The RAM 98 is sized to hold a sufficient number of received frames so as to avoid the RAM being overfilled during bridge operation. Since the network interface does not simultaneously transmit and receive, the LAN controller on each bridge side gives priority to receiving message frames. (*Koch, col. 13, lines 7 through 15*).

Furthermore, Koch refers to reading source and destination addresses for every frame received, and storing every incoming frame within the RAM 98 without regard to volume of contents received. (*Koch, col. 9, lines 7 through 22*). Since Koch is not concerned with monitoring the volume of frames, it teaches away from the claimed subject matter. Accordingly, Koch does not identically disclose (or suggest) a monitoring arrangement for monitoring a volume of incoming and outgoing data flowing through the network bridge and its memory, as provided for in the context of the claimed subject matter.

Also, Koch does not identically disclose (or suggest) a monitoring arrangement that is configurable by a higher-level instance, as provided for in the context of the claimed subject matter. Specifically, Koch's system receives all incoming frames, has the address reader read the source and destination addresses of the incoming frame, stores the address into a local RAM, and the system simultaneously stores the frame in memory 98 without the need to communicate with the processor to determine where the incoming frame should be stored. (*Koch, col. 8, lines 40 through 50; col. 9, lines 15 through 18*). These processes of Fig. 4a occur directly and routinely without any interference from any higher-level instance. Nowhere does Koch identically disclose (or suggest) that any part of the monitoring process may be configured by a higher level instance, as provided for in the context of the presently claimed subject matter.

For at least the foregoing reasons, claims 9 and 17, as presented, and their dependent claims are allowable.

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Koch in view of U.S. Patent 6,519,671 ("Kondou"). Applicants respectfully submit that the obviousness rejection should be withdrawn for at least the following reasons.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Also, as clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 10 depends on claim 9, as presented, and therefore claim 10 is allowable for the same reasons as claim 9, since the secondary reference does not cure – and is not asserted to cure – the critical deficiencies of the primary reference.

Claims 18 to 24 do not add any new matter and are supported by the present application, including the specification. Claims 18 to 21 depend from claim 17, as presented, and are therefore allowable for the same reasons. Claims 22 to 24 depend from claim 9, as presented, and are therefore allowable for the same reasons.

Accordingly, it is submitted that claims 9 to 13 and 15 to 24 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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